



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,513	05/05/2001	Dennis G. Earnshaw	1234-004/MMM	8685
33717	7590	09/19/2005	EXAMINER	
GREENBERG TRAURIG LLP 2450 COLORADO AVENUE, SUITE 400E SANTA MONICA, CA 90404			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/849,513

Applicant(s)

EARNSHAW, DENNIS G.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

This is in reference to response received 27 June 2005 to the office action mailed 09 June 2005, and, response received 22 March 2005 to the office action mailed 22 December 2004. There are 24 claims, claims 1 – 24 pending for examination.

### ***Response to Arguments***

In response to applicant's argument that in claim 1, cited reference eFax is directed towards transmitting documents in the same communication format to all parties, and, eFax does not teach sending the same document to multiple parties in different communication formats.

Applicant is arguing the amended claim which is responded to in response to the claim.

In response to applicant's argument that in claim 1, cited reference eFax in combination with IBM does not cure the deficiency of eFax.

Applicant is arguing the amended claim which is responded to in response to the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Information in eFax.com hereinafter known as eFax in view of Facsimile Support/400 Version 3 hereinafter known as IBM.

Regarding claims 1, 11 and 14, eFax teaches an electronic business transaction service system and method for conducting a business transaction over a computer network [page 8].

eFax does not explicitly teach creating on a first computer an electronic business transaction document that is compatible with a business management software program (design choice). However, IBM teaches creating on a first computer an electronic business transaction document that is compatible with a business management software program [IBM page 173 – 203].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify eFax as taught by IBM to save cost by automating the sending of documents through fax (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) ).

eFax in view of IBM teaches:

creating on a first computer an electronic business transaction document that is compatible with a business management software program (design choice), the electronic business transaction document being directed to plural recipient parties to a business transaction (field of use) [page 24], the electronic business transaction document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format (business choice, field of use) [page 11, 29];

transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer [page 29]; and

sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [IBM page 2 (IBM teaches its AS/400 capable of sending information to different communication format (computer to computer, computer to printer, computer to fax)), eFax page 29];

sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format [IBM page 2 (IBM teaches its AS/400 capable of sending information to different communication format (computer to computer, computer to printer, computer to fax)), eFax page 29].

Regarding claims 2 and 13, eFax in view of IBM teaches non-computer communication format includes telephonic facsimile [page 29].

Regarding claims 3, eFax in view of IBM teaches transmitting a printed copy of the electronic business transaction document to a recipient party (business choice, design choice) [page 29].

Regarding claims 4 and 15, eFax in view of IBM teaches storing in an electronic address book associated with the business management software program address information for each party and a communication format indication for each party indicating the one of the computer and non-computer communication formats in which to transmit communications to the party (design choice) [page 32].

Regarding claims 5 and 16, eFax in view of IBM teaches user selection of a party to receive an electronic business transaction document automatically associates with the party the communication format indicated in the communication format indication (design choice) [page 7, 29, IBM page 6, 101 – 112].

Regarding claims 6 and 17, eFax in view of IBM teaches charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server (business choice) [page 8].

Regarding claim 7, eFax in view of IBM teaches business management software program is capable of automatically populating and extracting information from electronic business transaction document (design choice), the method further including transmitting a business management software component in the computer format to the at least one recipient party, if it is determined that the at least one recipient party is not capable of viewing the electronic business transaction document, the business management software component not being capable of automatically populating and extracting information from electronic business transaction documents (design choice). [page 12].

Regarding claim 8, eFax in view of IBM teaches electronic business transaction document includes a markup language computer file [page 30, 31].

Regarding claim 9, eFax in view of IBM does not explicitly teach markup language computer file includes Extensible Markup Language. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a design choice to elect what technology to design the system with. A design may be made by using text delimited technology, TCP encapsulated messages, NetBIOS messages etc.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify eFax in view of IBM and use Extensible Markup Language to transfer the data over the internet using a widely used technology.

Regarding claims 10 and 18, eFax in view of IBM teaches capability to handle the business transaction relating to a construction project (field of use).

Regarding claim 12, eFax in view of IBM teaches communication format identifiers for the plural recipients include computer and non-computer communication formats [page 11, 29].

Regarding claim 19, eFax teaches an electronic business transaction service method for conducting a business transaction over a computer network [page 8].

eFax does not explicitly teach creating on a first computer an electronic business transaction document that is compatible with a business management software program (design choice). However, IBM teaches creating on a first computer an electronic business transaction document that is compatible with a business management software program [IBM page 173 – 203].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify eFax as taught by IBM to save cost by automating the sending of documents through fax (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) ).

eFax in view of IBM teaches:

creating on a first computer an electronic business transaction document that is compatible with a business management software program (design choice), the



Art Unit: 3629

electronic business transaction document being directed in one or more communication formats to plural recipient parties to a business transaction (business choice, field of use) [page 11, 29];

transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer [page 29]; and

sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [IBM page 2 (IBM teaches its AS/400 capable of sending information to different communication format (computer to computer, computer to printer, computer to fax)), eFax page 29];

sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format [IBM page 2 (IBM teaches its AS/400 capable of sending information to different communication format (computer to computer, computer to printer, computer to fax)), eFax page 29].

Regarding claim 20, eFax in view of IBM teaches communication formats includes telephonic facsimile [page 29].

eFax in view of IBM does not teach manually changing from the default communication format automatically associated with the party prior to sending the electronic business transaction document from to a recipient party.

Regarding claim 21, eFax in view of IBM storing in an electronic address book associated with the business management software program address information for each party and a communication format indication for each party indicating a default communication format in which to transmit communications to the party (design choice) [page 32].

Regarding claim 22, eFax in view of IBM teaches user selection of a party to receive an electronic business transaction document automatically associates with the party the default communication format indicated in the communication format indication [page 7, 29, IBM page 6, 101 – 112].

Regarding claim 23, response has been provided earlier in response under 35 USC 112 second paragraph.

Regarding claim 24, eFax in view of IBM teaches charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server (business choice) [page 8].

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

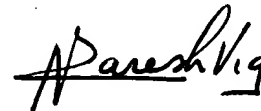
Applicant is required under 37 CFR 1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Naresh Vig", with a stylized flourish at the end.

Naresh Vig  
Patent Examiner  
Art Unit 3629

September 14, 2005